

ATTORNEY DOCKET NO.
004578.1123

PATENT APPLICATION
09/866,205

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REMARKS

Claims 1-2, 4, 6-11, 14-16, 18-21 and 25-38 are present in the application. In view of the remarks which follow, reconsideration is respectfully requested.

Patentable Subject Matter

Claims 10, 20 and 25-36 have previously been indicated to be allowed. In addition, Claims 37 and 38 have previously been indicated to be directed to allowable subject matter, such that they would be allowed if rewritten in independent form.

Rejection of Independent Claim 1

Claim 1 stands rejected under 35 U.S.C. §103 on the basis of an assertion that Claim 1 would be obvious if teachings drawn from document A were modified in view of teachings drawn from document B, where document A is the present application and document B is Randall U.S. Patent No. 6,100,477. If a patent application expressly states that certain disclosed subject matter is prior art, then that statement constitutes an admission which can be used as a basis for a rejection under §102 or §103 (see MPEP §2129). In the present situation, however, Applicants did not admit in their application that the portion of the application relied on by the Examiner is prior art. Consequently, as to this subject matter, the present application is not a document which qualifies as prior art for purposes of §102 or §103. Accordingly, the §103 rejection of Claim 1 is inherently defective, because it is based on a combination of subject matter drawn from document A and document B, but document A

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simply does not qualify as "prior art" for purposes for §103 in regard to the subject matter which the Examiner is drawing from it.

In the Advisory Action, the Examiner asserts that, even if document A does not constitute "prior art" as to the subject matter which the Examiner is drawing from it, there are other documents which are prior art and which show similar subject matter, including a patent to Goldsmith, and also an embodiment in the Randall patent which is different from the embodiment relied on in the §103 rejection. However, the pending §103 rejection is not based on Goldsmith, and thus the Goldsmith patent is completely irrelevant here. Similarly, the newly-identified embodiment of the Randall patent is irrelevant, because the pending rejection actually relies on subject matter from document A (i.e. the present application) rather than the newly-identified embodiment (which is a "prior art" figure in Randall).

In a sense, the Examiner is asserting that she could withdraw the existing §103 rejection and issue a new Office Action containing a new §103 rejection which is based on (1) a combination of Goldsmith and Randall or (2) a combination of two different embodiments drawn from Randall. The Examiner is entitled to withdraw the existing rejection and issue a new office action presenting a new and different rejection. But in the meantime, the fact that some other basis for a §103 rejection might possibly be presented in a future office action is not a cure for the fact that the current §103 rejection is inherently defective, due to the fact that it is based on two documents and one of the documents is simply not effective prior art as to the material which the Examiner is

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drawing from it. Accordingly, it is respectfully submitted that the current \$103 rejection must be withdrawn.

Separately from this problem, the Advisory Action also states that Applicants' arguments regarding the patentability of Claim 1 are not convincing. In this regard, the Advisory Action asserts that the Randall membrane has an outer portion with an "upper area" which is free of physical coupling to a base and a "lower area" which is coupled to the base, all "as claimed" by Applicants. However, Applicants' Claim 1 does not use terminology such as an "upper area" or a "lower area". Instead, the Examiner has fabricated claim limitations in the Advisory Action which are not actually present in Applicants' Claim 1, but which appear to be closer to the Randall structure than the actual language of Applicants' Claim 1. Applicants' prior arguments are based on the actual limitations of Claim 1, and these limitations are very clearly different from what is disclosed in Randall.

In particular, Claim 1 recites a membrane having two resilient sections and having two outer portions that each extend from one of the two resilient sections in a specified direction to one of first and second locations (at which the membrane is supported on a base section). Claim 1 emphasizes that each of the outer portions is "free of physical coupling to said base section except at a respective one of said first and second locations". Focusing on the actual language of Claim 1, rather than the Examiner's own claim language which appears in the Advisory Action, Claim 1 is very clearly distinct from Randall. Therefore, and since the \$103 rejection of Claim 1 is inherently defective for reasons

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discussed above, Claim 1 is believed to be allowable, and notice to that effect is respectfully requested.

Independent Claim 15

Independent Claim 15 is a method claim, and is subject to a rejection under 35 U.S.C. §103 that is effectively the same as the rejection applied to apparatus Claim 1. The §103 rejection of Claim 15 is inherently defective, for the same basic reasons discussed above in association with Claim 1. In addition, Claim 15 includes limitations similar to the limitations discussed above in association with Claim 1. Therefore, for reasons similar to those discussed above in association with Claim 1, it is respectfully submitted that Claim 15 is not obvious under §103 in view of the present application and Randall. Claim 15 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 2, 4, 6-9, 11 and 14 depend from Claim 1, and Claims 16, 18-19 and 21 depend from Claim 15. Claims 2, 4, 6-9, 11, 14, 16, 18-19 and 21 are also believed to be allowable over the art of record, for example for the same reasons discussed above with respect to Claims 1 and 15.

Conclusion

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that

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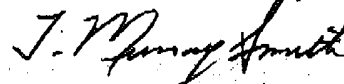
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examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at (214) 953-6684.

Respectfully submitted,
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Enclosures: None

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